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10/712,792	11/12/2003	Robert Gerald Kushner	50065.00008	7797
<div>7590 01/13/2009 STUART WHITTINGTON, ESQ. 7037 EAST MONTE CIRCLE MESA, AZ 85209</div>				
<div>EXAMINER MORGAN JR, JACK HOSMER</div>				
<div>ART UNIT 3782</div>		<div>PAPER NUMBER</div>		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT GERALD KUSHNER

Application 10/712,792
Technology Center 3700

Mailed: January 12, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.

BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on June 2, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated August 8, 2007. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. [Emphasis added.]

The “Summary of claimed subject matter” appearing on pages 2 and 3 of the Appeal Brief filed August 8, 2007 is deficient because it does not separately map independent claims 1, 9 and 17 to the specification. Correction is required.

APPEAL BRIEF, ARGUMENTS

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed August 8, 2007 under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 5, August 2006) for details.

EXAMINER’S ANSWER, MISSING CERTIFIED TRANSLATION

The Examiner relied on the foreign reference to Suzuki, JP 10226279, in rejecting the claims. A full certified English translation of the above-noted foreign reference is not of record in the Image File Wrapper (IFW).¹

When an Examiner relies on a document “in a language other than English, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection”

¹ It is noted that the IFW does contain a machine translation. However, the disclaimer on page 1 states: “This English translation is produced by machine translation and may contain errors. The JPO, the INPIT, and [] those who drafted this document in the original language are not responsible for the result of the translation.”

(emphasis added). MPEP §1207.02. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, . . . ; or (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

The memorandum also states “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added).

CONCLUSION

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on August 8, 2007 defective, as required by 37 CFR § 41.37(d);
- 2) to notify Appellant to file a revised Appeal Brief which corrects the “Summary of Claimed Subject Matter” under 37 CFR § 41.37(c)(1)(v) and properly presents the arguments for each grounds of rejection as required;
- 3) for consideration of the revised Appeal Brief;

4) to obtain a full certified English language translation for Suzuki, JP 10226279;

5) to complete the IFW by having the translation obtained scanned into the IFW file;

6) to provide a copy of the translation obtained to Appellant; and

7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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